

REMARKS

With entry of this amendment, claims 1-3 and 7-23 remain pending in this application, claims 1-3 and 7-20 stand rejected, and claims 21-23 of which have been newly added. Claims 4-6 have been cancelled, thereby rendering the rejections of these claims moot. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Claim Rejections-35 U.S.C. §102

Claim 8 stands rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 6,231,570 issued to Tu, et al. ("Tu"). Applicant respectfully traverses this rejection, since Tu does not disclose each and every element required by these claims, as amended.

In particular, independent claim 8 has been amended to clarify that each electrode takes the form of an elongated, solid metallic, resilient member, as opposed to the microcatheter disclosed in Tu, which does not form a solid metallic member.

Thus, Applicant submits that claim 8 is not anticipated by Tu, and as such, respectfully request withdrawal of the §102 rejection of this claim.

Claim Rejections-35 U.S.C. §103

Tu and LeVeen

Claims 1-8 stand rejected under 35 U.S.C. §103, as being obvious over Tu in view of U.S. Patent No. 6,575,967 issued to LeVeen, et al. ("LeVeen"). Applicant respectfully traverses this rejection, since neither Tu nor LeVeen, alone or in combination, discloses, teaches, or suggests the combination of elements required by these claims, as amended.

In particular, like claim 8, independent claim 1 has been amended to clarify that each electrode takes the form of an elongated, solid metallic, resilient member. As discussed above, Tu does not disclose, teach, or suggest such an electrode. While LeVeen does disclose such an electrode, there is no suggestion to transform the microcatheters of Tu into these electrodes.

It is established principle that “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” (See M.P.E.P. §2141.02). A reading of Tu, as a whole, would suggest to one of ordinary skill in the art that only microcatheters should be used. The specification of Tu is replete with references to microcatheters. As used by Tu, as well as those of ordinary skill in the art, a microcatheter is a relatively small member that carries functional components, such as electrodes. They are not the electrodes themselves. Thus, Tu teaches away from modifying the microcatheters into solid metallic electrodes.

It is also an established principle that if a proposed modification would render the prior art device or method being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (See M.P.E.P. §2143.01). The purpose of the Tu device is to provide a means to cool an electrode (see col. 2, lines 41-45), and Tu accomplishes this by incorporating lumens into microcatheters (see bstract; col. 2, lines 61-67). Transforming the microcatheters of Tu into solid metallic electrodes would of course defeat this purpose.

Thus, Applicant submits that independent claims 1 and 8, as well as the claims depending from claim 1 (claims 2-7), are not obvious over the combination of Tu and LeVeen, and as such, respectfully request withdrawal of the §103 rejections of these claims.

Tu, LeVeen, and Balbierz

Claims 9-20 stand rejected under 35 U.S.C. §103, as being obvious over Tu, in view of LeVeen, in further view of U.S. Patent No. 6,770,070 issued to Balbierz, et al. ("Balbierz"). Applicant respectfully traverses this rejection, since none of Tu, LeVeen, or Balbierz, alone or in combination, discloses, teaches, or suggests the combination of elements required by these claims, as amended.

In particular, like independent claims 1 and 8, independent claim 15 has been amended to clarify that each electrode takes the form of an elongated, solid metallic, resilient member. As discussed above, Tu and LeVeen do not disclose, teach, or suggest using such an electrode in an array of electrodes with the claimed geometry, and Balbierz fails to supplement this failed teaching.

Thus, Applicant submits that claims 9-20 are not obvious over the combination of Tu, LeVeen, and Balbierz, and as such, respectfully request withdrawal of the §103 rejections of these claims.

New Claims

Applicant submits that newly added claims 21-23 find support in the specification, as originally filed, and are patentable over the prior art for at least the same reasons as independent claims 1, 8, and 15 from which they respectively depend are.

Conclusion

Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at (949) 939-1777.

Respectfully submitted,



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Dated: February 28, 2006

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